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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,193	05/23/2000	Kia Silverbrook	NPB001US	9142

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/575,193

Applicant(s)
Silverbrook et al.

Examiner
John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 23, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 & 4 6) ☐ Other:

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DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts 5,772,510; class 463/17 (06/30/1998).

As per claim 1, Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1.65) shows: “A system for providing to a user printed information obtained from a remote source, the system including: a user module that is provided by a first party to the user for interfacing the user with the source, the module being responsive to the user requesting first information from the source for generating a first printed medium that displays to the user the first information together with second information derived from a second party; identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information; and calculation means being responsive to the module for determining a payment to be made by the second party to the first party.”

Roberts lacks explicit recitation of “identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information. . . .” even though Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests same. It would have been obvious to a person of ordinary

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skill in the art at the time of the invention that the disclosure of Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) would have been selected in accordance with “identifier means for applying an identifier to the first printed medium such that designation of the identifier by the user results in the module generating a second printed medium that displays to the user third information. . . .” because such selection would have provided “*an improved lottery ticket terminal for providing completed lottery tickets.*” (See Roberts (col. 1, ll. 65-67)).

As per dependent claims 2-25, Roberts shows the system of claim 1 and subsequent base claims depending from claim 1.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 2-25.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 2-25.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 2-25 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary

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skill in the art at the time of the invention to include the elements and limitations of dependent claims 2-25, because such elements and limitations would have provided “*an improved lottery ticket terminal for providing completed lottery tickets.*” (See Roberts (col. 1, ll. 65-67)).

Independent claim 26 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 27-30, Roberts shows the system of claim 26 and subsequent base claims depending from claim 26.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 27-30.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 27-30.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 27-30 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 27-30, because such elements and limitations would have provided “*an*

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improved lottery ticket terminal for providing completed lottery tickets.” (See Roberts (col. 1, ll. 65-67)).

Independent claim 31 is rejected for the same reasons as independent claim 1.

As per dependent claims 32-55, Roberts shows the system of claim 31 and subsequent base claims depending from claim 31.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 32-55.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 32-55.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 32-55 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 32-55, because such elements and limitations would have provided “*an improved lottery ticket terminal for providing completed lottery tickets.” (See Roberts (col. 1, ll. 65-67)).*

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Independent claim 56 is rejected for the same reasons as independent claim 26.

As per dependent claims 57-60, Roberts shows the system of claim 56 and subsequent base claims depending from claim 56.

Roberts (FIG. 1; FIG. 4; FIG. 2A; FIG. 2B; FIG. 2C; FIG. 3; FIG. 6A; FIG. 7; FIG. 8A; FIG. 8B; the ABSTRACT; col. 1, ll. 65-67; col. 2, ll. 13-67; col. 4, ll. 1-5; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1.65; and whole document) reasonably suggests all of the elements and limitations of dependent claims 57-60.

Roberts lacks explicit recitation of some of the elements and limitations of dependent claims 57-60.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 57-60 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 57-60, because such elements and limitations would have provided “*an improved lottery ticket terminal for providing completed lottery tickets.*” (See Roberts (col. 1, ll. 65-67)).

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CONCLUSION

3. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

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(Silverbrook et al.)

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'John L. Young', is written over the printed name.

John L. Young

Patent Examiner

July 31, 2003